

### REMARKS

This Letter and Response to Final Rejection is respectfully submitted in order to transmit the attached Request for Continued Prosecution, copy of Petition to Change Inventorship filed in parent application Serial No. 09/206,249 and the accompanying Assignment and Supplemental Declaration. This paper also addresses the Final Rejection of August 12, 2004. Also filed concurrently herewith is a Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b).

Applicants respectfully amend the Specification of the above-captioned patent application in order to correct the claim of benefit of priority to Provisional Patent Application No. 60/069,797 filed December 16, 1997. This claim of priority was inadvertently omitted in the original Declaration and was only discovered upon recent review of the application file. Applicants also respectfully submit herewith a copy of the Supplemental Declaration filed in the parent application Serial No. 09/20,249 which both reflects the proper inventorship and amends the Declaration to reflect the relationship between the above-identified patent application and Provisional Patent Application No. 60/069,797, filed December 16, 1997, which was inadvertently omitted from the original declaration. Applicants respectfully request that the claim of the benefit of priority from Provisional Patent Application No. 60/069,797 be granted.

Applicants also respectfully submit that the inventorship of the above-identified patent application inadvertently omitted Dr. Michael Costanzo when the application was originally filed. The remaining inventors are in agreement with adding Dr. Costanzo to the inventorship, as evidenced by the attached copy of a Petition to Change Inventorship and Supplemental Declaration.

The accompanying Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b) is respectfully submitted with respect to the discovery that the time for response and/or or filing an Appeal Brief had passed due to an omission in docketing the due date for this time period. Applicants respectfully request the grant of the accompanying Petition.

The Final Rejection of August 12, 2004 provisionally rejected claims 24, 28-30, 38, 40 and 44-46 under 35 U.S.C. 102(e) as being anticipated by copending Application Serial No. 09/110,409. The basis for this provisional rejection is that Serial No. 09/110,409 "discloses the

composition of STI...and a cosmetically acceptable carrier/vehicle and discloses an method of using the composition which inherently will decrease phagocytosis of ICAM-1 expression in a mammalian cell as in the instant application.” [Final Rejection, p. 3]

Applicants respectfully requests reconsideration of the foregoing rejection in view of the ensuing discussion. The Final Rejection states that “on page 20 of the instant specification, applicant admits that they can use the instant invention for treating what applicant is treating in 09/110,409, skin pigmentation. Thus there is no difference between the two applications.” [Final Rejection, p. 3]. Applicants respectfully suggest that the statute requires that, in order to be an anticipatory reference, the cited reference itself should disclose the claimed invention. Applicants respectfully submit that the Final Rejection is quoting the **instant** specification, which was filed **after** Serial No. 09/110,409, **not** the earlier application—the earlier application nowhere indicates or recognizes the method of use set forth in the claims of the instant application. Applicants respectfully submit that, again, this rejection is premature and should be held in abeyance until claims of 09/110,409 are issued in a patent. Applicants respectfully submit that they could not present claims corresponding to those of the instant application in the other copending application in light of the fact that the claims of the instant application would require basis in the Specification for treating or preventing disorders ameliorated by decreasing phagocytosis or ICAM-1 expression. Applicants respectfully request reconsideration of the foregoing provisional rejection under 35 U.S.C. 102(e).

The Office Action of August 12, 2004, again rejected claims 24, 28-30, 38, 40, and 44-46 under 35 U.S.C. §102(b) as being anticipated by Holmgren et al. (col. 17), Hammonds, Jr. et al. (col. 36) and Hammonds, Jr. et al. (col. 37) on the ground that although applicants argued that the references “do not administer STI to a patient as claimed, but as claimed, the patient could have any condition.” [Final Rejection, p. 4]. Applicants respectfully request reconsideration of this rejection in view of the ensuing discussion.

Applicants respectfully submit that, as claimed, the method of their invention requires that the patient is **in need of** a decrease of phagocytosis or ICAM-1 expression. Thus, the patient could not “have **any** condition”, but a condition that requires the decrease of phagocytosis or ICAM-1 expression. Applicants respectfully submit that neither Holmgren et al. nor Hammonds, Jr. et al. would anticipate the method of their claims as set forth herein. Thus, reconsideration of the rejection under 35 U.S.C. 102(b) is respectfully requested.

The Final Rejection of August 12, 2004 further rejected claims 24, 28-30, 38, 40, and 44-46 under 35 U.S.C. § 102(e) as being anticipated by Costanzo. Applicants respectfully request reconsideration of this rejection in light of the foregoing discussion and accompanying papers.

As set forth in the foregoing discussion, both this application and its parent, Serial No. 09/206,249 inadvertently omitted reference to Provisional Patent Application Serial No. 60/069,797, filed December 16, 1997. This provisional patent application was filed prior to the filing date of the patent application on which Costanzo issued. As set forth above, applicants respectfully request correction of this inadvertent error by claiming the benefit of priority of Provisional Patent Application Serial No. 60/069,797. Applicants respectfully submit that the foregoing discussion and request address the concerns with respect to the Costanzo patent and respectfully request reconsideration of the rejection of the claims under 35 U.S.C. 102(e) in view of Costanzo.

The Office Action of January 29, 2003 also provisionally rejected claims 24, 28-30, 38, 40, 44-46 under 35 U.S.C. 101 and under the judicially created doctrine of obviousness-type double patenting over claims 1-25, 56-59 of copending Application Serial No. 09/110,409. Applicants respectfully request reconsideration of this rejection.

Applicants respectfully submit that Serial No. 09/110,409 neither suggests nor describes the methods of applicants' invention and, therefore, the claims are not coextensive in scope. Nowhere therein is there a suggestion that STI or other members of the delineated Markush group of the claims would be useful in treating or preventing disorders ameliorated by decreasing phagocytosis or ICAM-1 expression. Applicants respectfully submit that, again, this rejection is premature and should be held in abeyance until claims of 09/110,409 are issued in a patent. Applicants respectfully submit that they could not present claims corresponding to those of the instant application in the other copending application in light of the fact that the claims of the instant application would require basis in the Specification for treating or preventing disorders ameliorated by decreasing phagocytosis or ICAM-1 expression in patients in need thereof. Applicants respectfully request reconsideration of the rejections under 35 U.S.C. §101 and the judicially created doctrine of obviousness-type double patenting in view of the foregoing discussion.

Applicants respectfully request reconsideration of the above-mentioned rejections under 35 U.S.C. 102(b) and (e) in light of the foregoing amendments to the claims, the accompanying papers and the foregoing discussion.

Applicants respectfully request correction of the claim of the benefit of priority with respect to the abovementioned provisional patent application, addition of Michael Costanzo to the inventorship of the above-captioned patent application and reconsideration of the rejections set forth in the Final Rejection of August 12, 2004. Applicants also respectfully request the grant of the accompanying Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b). An early allowance is earnestly solicited.

Respectfully submitted,

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Dated: June 14, 2005